

REMARKS

Upon entry of the above amendments, claims 1-12 and 21-33 will be pending. These claims include claims 1-12 which are directed to a financial services outsourcing method, claims 21-30 which are directed to apparatus including a tracker, claim 31 which is directed to a financial services outsourcing method, claim 32 which is directed to a financial services outsourcing method, and claim 33 which is directed to a financial services outsourcing method.

Applicants respectfully request reconsideration and allowance of the present application in view of the above amendments and the following remarks.

The Office Action rejects claim 1 under 35 U.S.C. § 112, indicating that the limitation "the ultimate" lacks sufficient antecedent basis. Applicants note that the claims now presented do not have this term. Accordingly, Applicants believe that this rejection has been overcome.

Claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker (U.S. Patent No. 6,473,741) in view of Dang et al. (Published Patent Application 2003/0101111).

Initially, for the record, Applicants note some assertions made in the outstanding Office Action that are inaccurate. The assertions go beyond interpreting claim language with a broad reasonable interpretation per MPEP 2111. For example, in the paragraph bridging pages 2 and 3 of the Office Action, it is asserted that Baker discloses, at column 3, lines 1-46, recited claim limitations of "retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country", and further asserts that Baker teaches at column 7, lines 41-67, "monitoring and reporting the status of the tax return preparation and of the other financial service projects".

Applicants do not understand the association of the mentioned portion of the Baker patent with the claim limitations.

The portion referred to in the Baker patent explains that the American Institute of Certified Public Accountants has created what is called the "CPA Vision Project." The project has identified seven economic platforms that will affect the profession of accounting in the

future. No mention is made of the outsourcing of the performance of tax return preparation services. No mention is made of retaining outsourced personnel to perform such services for clients of direct service providers during a tax season in a given year. No mention is made at this portion of the Baker patent of performing other financial service projects for the clients of the direct service providers during a different season of the given year. No mention is made of the outsourced personnel preparing tax returns or performing other financial service projects, each while in an outsourced country different from the given country. In addition, no mention is made of outsourcing any services to a different country.

Applicants trust that these observations are sufficient to indicate that Applicants do not acquiesce to any of the characterizations of the references made in this Office Action.

Applicants note that the Baker patent is directed to a process that allows certain valuable data to be gathered, which can be useful in two ways. For example, as described in the Abstract of the Baker patent, the data can be exchanged to provide new revenue streams. In addition, the data can be grouped into data warehouses of other firms. The Baker patent talks about how the data can be sold or rented creating additional revenue streams for the originators of the data, and that purchasers of this bulk data may be interested in using the data in the field of data mining.

It is evident that the Baker patent is not concerned with outsourcing of tax return preparation services. Rather, the Baker patent is concerned with processes for gathering and warehousing data, and for selling that data, in order to provide additional sources of profits and revenue for accounting firms.

Put simply, the Baker patent is quite a different animal from the features and limitations recited in the claims of the present application.

The Dang et al. published patent application is directed to a system that allows for and facilitates automated tax calculation (referred to as financial data computation, for example, at lines 2-3 of the Abstract) and payment of taxes (referred to as revenue remittance over an interactive communications network, at lines 2-4 of the Abstract.).

Applicants note that Dang et al., at paragraph 0108, teaches that the methods disclosed offer "many benefits over conventional methods of tax preparation and reporting." The published patent application goes on to explain that the methods enable "subscribers to

electronically *outsource* the burden of sales and/or use tax calculations and remittance to state-certified service providers...” (Emphasis added by the undersigned).

Applicants do not understand what types of “leaps” and assumptions might be made from this language at paragraph 0108 of the Dang et al. published patent application. However, Applicants must point out that, even if, *arguendo*, one of ordinary skill were to be motivated to consider the teachings of paragraph 0108 of the Dang et al. published patent application, and to modify a system, such as the Baker system, to include some features to allow for electronic outsourcing of sales and use tax calculation or remittance to state-certified service providers, the resulting modified system would still nonetheless be lacking several important limitations as recited in each of the independent claims in the present application.

For example, the combination is still lacking, *inter alia*, the *claim 1* recited limitation where the outsourced personnel perform tax return preparation services during the tax season in the given year and perform the financial service projects during a different season of the given year through a remote limited access client located in the outsource country.

In addition, the combination is still lacking, *inter alia*, the *independent claim 21* recited limitations including a tracker configured to log certain tax return status indications and including stored data representations of actual logged status indications, the tracker including a tax service provider interface configured to receive tax service provider status change events from a computer system, the tax service provider status change events including a ready for access event indicating that a tax preparation process for a given client is at a stage where both a tax file and supporting e-documentation are ready for access by given personnel.

In addition, the combination is still lacking, *inter alia*, the *independent claim 31* recited limitations including for plural respective direct service providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and the corresponding reference materials, and including retaining personnel outside the given country to perform tax return preparation services for clients of the direct service providers during a tax season.

Moreover, the combination is still lacking, *inter alia*, the *independent claim 32* recited limitations including retaining outsourced personnel to perform financial service projects for

respective clients of the financial services firms, the outsourced personnel performing the financial service projects while located outside the United States, including providing the outsourced personnel limited access to the server, including the outsourced personnel performing the financial service projects through a remote limited access client located outside the United States connected to the host server, and including monitoring and reporting the status of the financial service projects.

Even still, the combination is still lacking, *inter alia*, the *independent claim 33* recited limitations including for plural respective direct services providers, loading, onto a remotely accessible part of a common host server, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and the corresponding reference materials, including retaining outsourced personnel to prepare a set of tax returns including tax returns for both the first set of clients and the second set of clients, the outsourced personnel preparing the set of tax returns while located outside the first and second countries, including providing the outsourced personnel limited access to the host server, including the outsourced personnel preparing the set of tax returns through a remote limited access client located outside the first and second countries connected to the host server, and including monitoring and reporting the status of each of the returns in the set of tax returns.

In the event the Examiner uses an interpretation of the claim language some might consider "creative"¹, i.e., not readily apparent when one reads the claims in light of the specification, Applicants implore the Examiner to elaborate on how each limitation is being interpreted. Otherwise, Applicants will not have the opportunity to consider whether more explicit wording can be added to make the "interpretation argument" mute. In other words, Applicants welcome the opportunity to add claim language to make clear an interpretation which Applicants intend, rather than argue whether the "broad reasonable" interpretation given by the Examiner is or is not appropriate per MPEP 2111.

None of the references of record, whether considered alone or in any proper combination, provides any teachings that would render the limitations recited in each of the independent

¹ Such a "creative" interpretation may be considered by some as at or beyond the limits of what one might argue is a broad reasonable interpretation per MPEP 2111.

claims in the present application obvious. Accordingly, Applicants submit that each of claims 1-12 and 21-33 is patentable under 35 U.S.C. §§ 102 and 103.


Applicants note that the presently-pending claims include claims that are supported by the present application as originally filed, as well as by provisional patent application No. 60/428,998 filed on November 25, 2002. Moreover, Applicants note that new claims 31 and 32 include claims similar in some respects (respectively) to claim 1 of related application No. 10/608,664 filed on June 27, 2003 and claim 1 of related application No. 10/609,033 also filed on June 27, 2003. Applicants are hereby presenting claims 31 and 32 into the present application, in accordance with the spirit of the new rules concerning continuation and claim practice. Should the Examiner believe that a Restriction Requirement is appropriate, the Examiner is invited to make such a requirement. On the other hand, should the Examiner believe that it would more efficient for the Examiner to consider and examine all of the claims in the present application, without a Restriction Requirement, Applicants would be amenable to prosecuting these claims in the present application without prosecuting them as divisionals.

In view of the foregoing, reconsideration and allowance of the present application are respectfully requested. A Notice to that effect is earnestly solicited.

Should the Examiner have any questions regarding the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number

Respectfully submitted,

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